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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,134	08/06/2001	Atle Hedloy	103176-0001C1	9141
24267 7590 11/09/2007 CESARI AND MCKENNA, LLP 88 BLACK FALCON AVENUE BOSTON, MA 02210			EXAMINER LUU, SY D	
			ART UNIT 2174	PAPER NUMBER
			MAIL DATE 11/09/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/923,134

Applicant(s)

HEDLOY, ATLE

Examiner

Sy D. Luu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 35-108 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35-69 is/are allowed.
- 6) ☒ Claim(s) 70-108 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/3/05, 8/26/04, 8/18/04,
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 35-135 are pending in this application. Claims 35, 53, 59, 65, 70, 77, 84, 91, 97, 103, 119-120, 127, 130-135 are independent claims. This action is made Non-Final.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Allowable Subject Matter***

3. Applicant is advised that the Notice of Allowance mailed is vacated. If the issue fee has already been paid, applicant may request a refund or request that the fee be credited to a deposit account. However, applicant may wait until the application is either found allowable or held abandoned. If allowed, upon receipt of a new Notice of Allowance, applicant may request that the previously submitted issue fee be applied. If abandoned, applicant may request refund or credit to a specified Deposit Account.

The indicated allowability of claims 35-135 is withdrawn in view of the newly discovered reference(s) to Addressmate for Windows Version 2.0. Rejections based on the newly cited reference(s) follow.

### ***Claim Objections***

Claims 91 and 115 are objected to because of the following informalities:

- (a) the term "the first" on line 5 of claim 91 is incomplete.

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(a) the term "selection" on line 2 of claim 5 should be changed to "selecting" in order to remain consistent with the claim language.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

4. Claims 35-135 are rejected under 35 U.S.C. 103(a) as being unpatentable over Addressmate for Windows Version 2.0 ("Addressmate") in view of Pandit (U.S. patent 5,859,636).

As per claim 35, Addressmate teaches a method for information handling within a document created using a first application program comprising the steps of:

entering a first information in the first application program, wherein the first information can be utilized in a second application program (page MS 118624; *step 1 in the illustration*); and

responding to a user selection (page MS 118624; *step 2 in the illustration*) by inserting a second information into the document, the second information associated with the first information from a second application program (page MS 118624; *step 3 in the illustration*).

Addressmate does not expressly disclose the step of marking without user intervention the first information to alert the user that the first information can be utilized in a second application program. However, it is known in the art that information can be marked so that a user is informed of its possible use in other applications. For instance, Pandit teaches "recognition of text in a body of text as belonging to a predetermined class and performing an operation relevant to the recognized text" (col.1, lines 51-53). Pandit also teaches marked information, with highlighted text 11, 14, 16, at figures 1a-1f, and col. 2, lines 5-6, 51,64-

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65). It would have been obvious to an artisan at the time of the invention to to include the accented text of Pandit in the invention of Tso because it allows for "transforming the text into an interface to other functions or operations".

As per claim 36, Addressmate teaches a user interface device (page MS 118624; *see illustrations*).

As per claims 37-40, Addressmate teaches the steps of: initializing the second application, using the second application to search for the second information associated with the first information, and retrieving the second information (page MS 118624; *step 2 in the illustration*); displaying the second information, and completing the first or second information (page MS 118624; *step 3 in the illustration*); the first information comprises a name (page MS 118624; *step 1*).

Claims 41-46 are similar in scope to claims 35-40 respectively, and are therefore rejected under similar rationale.

Claims 47-52 are similar in scope to claims 35-40 respectively, and are therefore rejected under similar rationale.

Claims 53-54 are similar in scope to claims 35 and 38 respectively, and are therefore rejected under similar rationale.

Claim 55 is similar in scope to claim 40, and is therefore rejected under similar rationale. Addressmate further teaches the operation performed is selected from a letter addressed to the name indicated by the first information (page MS 118624; *see illustrations*). Pandit also teaches name information (column 7, line 43), and operations selected from a group consisting of an e-

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mail, a telex, a fax, or a letter (column 2, lines 39-41, 58-59; and column 2, line 67 to column 3, line 8).

As per claims 56-58, Addressmate teaches entering additional data located within the document by a user into a database (page MS 118624; on the left column under the “Save Address” heading; *saving the address from the letter to the database*).

Claims 59-64 are similar in scope to claims 53-58 respectively, and are therefore rejected under similar rationale.

Claims 65-69 are similar in scope to claims 53-57 respectively, and are therefore rejected under similar rationale.

Claims 70-72 are similar in scope to claims 35-37 respectively, and are therefore rejected under similar rationale.

As per claim 73, Addressmate teaches the step of adding the second information to the first information in the document (page MS 118624; *step 3*).

Claims 74-76 are similar in scope to claims 38-40 respectively, and are therefore rejected under similar rationale.

Claims 77-83 are similar in scope to claims 70-76 respectively, and are therefore rejected under similar rationale.

Claims 84-90 are similar in scope to claims 70-76 respectively, and are therefore rejected under similar rationale.

Claims 91-96 are similar in scope to claims 53-58 respectively, and are therefore rejected under similar rationale.

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Claims 97-102 are similar in scope to claims 53-58 respectively, and are therefore rejected under similar rationale.

Claims 103-108 are similar in scope to claims 53-58 respectively, and are therefore rejected under similar rationale.

As per claims 109-111, Addressmate teaches the user selection comprising an activation of a menu, and the identifying or at least part of the identifying occurs after the user selection (page MS 118624; *step 2 shows a menu for selection and identifying or at least identifying of the information after the user selection* ).

Claims 112-114 are similar in scope to claims 72, 74, and 76 respectively, and are therefore rejected under similar rationale.

As per claims 115-117, Addressmate teaches the activation of the menu to comprise: selection the menu indicator for the menu, opening the menu, selecting a choice in the menu, and activating the selected choice in the menu, moving a mouse pointer to the menu button (page MS 118624; *step 2*).

As per claims 117-118, Addressmate and Pandit do not expressly teach the step of clicking on the menu indicator with a mouse button, and the second information being associated with only part of the identified first information. However, official notice is taken that such features are well known in the art. It would have been obvious to an artisan at the time of the invention to combine these features with the method of Addressmate in order to provide a convenient means for making selection from the display, as well as a quicker means to search and retrieve the desired information.

Claim 119 is similar in scope to the combination of claims 91, 55, 112, and 115-118, and is therefore rejected under similar rationale.

Claims 120-126 are similar in scope to claim 35, and is therefore rejected under similar rationale. Addressmate further discloses the name to comprise a personal name, a business name, and an address (page MS 118624; *step 3*).

Addressmate does not expressly disclose a telephone number, and all the steps to require only a single execute command. However, the use of a single command to execute a series of steps, as well as associating phone numbers with name are well known in the art. It would have been obvious to an artisan at the time of the invention to include this type operation in order to provide users with a convenient way of executing related commands all in one quick step, as well as storing pertinent information such as phone number associated with names.

Claims 127-129 are similar in scope to claims 120 and 125 respectively, and are therefore rejected under similar rationale.

Claims 130-135 are similar in scope to claims 119-120, 120, 119 and 127 respectively, and are therefore rejected under similar rationale.

### ***Inquires***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sy Luu whose telephone number is (571) 272-4064. The examiner can normally be reached on Monday - Friday from 7:300 am to 4:00 pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached on (571) 272-4063.



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The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Sy D. Luu/  
Sy D. Luu  
Primary Examiner